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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/668,560 | 09/22/2003 | Robert P. Bartholomew | AC00032-001 (26668-56) | 2920 |

73824 7590 08/19/2010
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| EXAMINER |
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D'AGOSTINO, PAUL ANTHONY

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| ART UNIT | PAPER NUMBER |
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3714

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

08/19/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/668,560 | Applicant(s) BARTHOLOMEW ET AL. | |
| | Examiner Paul A. D'Agostino | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-38,40-73,75,76 and 78-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,8-20,22,26,40,41,43,44,52-53, 58-71,73,75,76,78-88 and 90-92 is/are allowed.
- 6) ☒ Claim(s) 21,23-25,27-38,42,45-51,54-57,72 and 89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 7/12/2010. Claims 1, 23, 58-73, 75-76, and 78-92 have been amended. Claims 7, 39, 74, and 77 stand cancelled. Claims 1-6, 8-38, 40-73, 75-76, and 78-92 are pending in this application.

Response to Amendments

1. Examiner appreciates Applicant clarifying the status of Claims 1, 23 and 58 as to status identifiers and the rejection under 35 U.S.C. § 112, second paragraph. The objection and rejection of the appropriate claims are withdrawn.
2. Applicant has appropriately amended Claim 58 curing the rejection under 35 U.S.C. § 101. The rejection of the claim is withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 21, 37, 54, 72, and 89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claims 21, 37, 54, 72, and 89 fail to further limit the independent claim. In fact, they set the default award to nothing (Applicant's Specification Page 7) thus improper broadening the claim by removing the limitation of presenting a default award and executing the non-default awards.. Examiner recommends cancelling the claims and amending Claims 1, 23, and

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58 to recite the limitation consistent with Fig. 7A with the system and method of Fig. 7A.

Appropriate attention is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 23-25, 27-38, 42, 45-51, and 54-57 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or material) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

a. Claim 23 recites a method of awarding a default bonus and a non-default bonus during a bonus round. The entire method can be performed without machine implementation. Furthermore, there is a transference of bonus awards but this is not a transformation just a change of assignment for 101 purposes.

b. Claim 24 recites an instrumentality of a player tracking database deeded extra-solution activity as imposing a meaningless limitation on the independent claim. Furthermore, Claim 24 contains an additional litany of mental steps.

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- c. Claim 25 suggests a gaming machine however not in use as in claim 26.
- d. Claims 27-38 and 42 comprise mental steps or wherein the steps can be done by hand thereby not implicating machine implementation.
- e. Claims 45-51 recite mental steps (notifying) and instrumentalities (test message, audio announcement, video announcement and simulating) which do not further limit the independent claim in a meaningful way.
- f. Claims 55-57 recite mental steps.

Allowable Subject Matter

- 7. Claims 1-6, 8-20, 22, 26, 40-41, 43-44, 52-53, 58-71, 73, 75-76, 78-88, and 90-92 are allowable over prior art.
- 8. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record neither anticipates nor renders obvious Applicant's claimed invention wherein, in combination with the other claimed limitations, wherein a set of bonus awards including at least two bonus awards, including at least a non-zero default award and a plurality of non-default awards wherein the default award is reused after being awarded during an active bonus session and wherein each of the non-default awards is used a single time during the active bonus session.

Response to Arguments

9. Applicant's amendments have been considered and are persuasive. Additionally, as more guidance has been provided subsequent to the *In re Bilski* decision, Examiner has presented new grounds of rejection for Applicant's consideration.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Paul A. D'Agostino/
Examiner, Art Unit 3714